

Application No. 10/600,518
Amendment dated January 16, 2007
Response to Office Action of October 16, 2007

Atty. Docket No. 42P15475
Examiner Philippe, Gims S.
TC/A.U. 2621

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 21 and 27 have been amended. No claims have been added or canceled. Thus, claims 1-32 are pending.

CLAIM REJECTIONS – 35 U.S.C. § 102(e)

Claims 1-3, 21-23, 27 and 28 were rejected as being anticipated by U.S. Patent No. 6,671,408 issued to Kaku (*Kaku*). For at least the reasons set forth below, Applicants submit that claims 1-3, 21-23, 27 and 28 are not anticipated by *Kaku*.

Claim 1 recites:

selecting a base frame from a group of frames of a digital video data stream, wherein at least one frame in the group of frames is encoded with an encoding technique utilizing bi-directional encoding;
decompressing the selected base frame prior to decompressing other frames of the group of frames; and
providing the decompressed base frame to a display device for display prior to decompressing the other frames of the group of frames.

Thus, Applicants claim decompressing a group of frames that have been encoded utilizing bi-directional encoding after decompressing and providing to a display device a selected base frame. Claims 21 and 27 similarly recite decompressing a group of frames that have been encoded utilizing bi-directional encoding after decompressing and providing to a display device a selected base frame.

Kaku discloses a technique for compressing and decompressing a single frame. See col. 1, lines 40-48. In contrast, the claims recite decompressing a selected base frame from a group of frames encoded utilizing bi-directional encoding. Because *Kaku*

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discloses compression and decompression of single frames, *Kaku* cannot disclose bi-directional encoding. Therefore, *Kaku* cannot anticipate the invention as claimed in claims 1, 21 and 27.

Claims 2 and 3 depend from claim 1. Claims 22 and 23 depend from claim 21. Claim 28 depends from claim 27. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2, 3, 22, 23 and 28 are not anticipated by *Kaku* for at least the reasons set forth above.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 4 and 29 were rejected as being unpatentable over *Kaku* in view of U.S. Patent Publication No. 2003/0014748 A1 of Ben-David, et al. (*Ben-David*). For at least the reasons set forth below, Applicants submit that claims 4 and 29 are not rendered obvious by *Kaku* and *Ben-David*. Claim 4 depends from claim 1. Claim 29 depends from claim 27.

Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination proposed in an Office Action. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434, 1438 (CAFC 1988). Although an Office Action may suggest that an element of a primary prior art reference *could* be modified in view of a secondary prior art reference to form the claimed structure, the mere fact that the prior art *could* be so modified would not make the modification obvious unless the prior art suggested the desirability of the modification (emphasis added). In re Laskowski, 871 F.2d 115, 10 USPQ2d 1297 (CAFC 1989). There must be some supporting teaching in the prior art for the proposed combination of references to be

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proper. In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (CAFC 1989).

Ben-David is cited to disclose MPEG encoding. However, because *Kaku* discloses single frame encoding, it does not appear to provide any motivation for use with MPEG or other types of encoding. Therefore, the combination of *Kaku* and *Ben-David* cannot be used to reject claims 4 and 29.

ALLOWABLE SUBJECT MATTER

Claims 5-20, 24-26 and 30-32 were allowed. Applicants would like to thank the Examiner for identifying allowable subject matter.

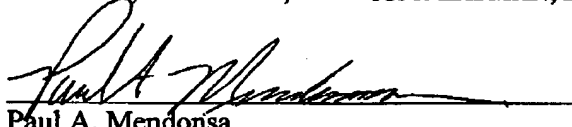
CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-32 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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